

App. No.: 10/646,994
Amendment

R E M A R K S

Reconsideration of the application in view of the above amendments and the following remarks is respectfully requested. Claims 1, 17 and 18 are currently being amended, and no claims are currently being canceled or added. Therefore, claims 1-28 remain pending in the application.

Additional Supplemental IDS Filed

Applicants have submitted herewith another Supplemental Information Disclosure Statement for this application. Applicants request that the Examiner consider the references listed therein and return a copy of the signed Form PTO-1449 with the next paper for this application.

Extension of Time

A Petition and Fee for a two-month extension of time is submitted herewith to extend the period for response to April 17, 2006.

Written Statement regarding Substance of 2/28/06 Interview per 37 CFR 1.133(b)

Applicants appreciate very much the opportunity to discuss the rejections in this application with Examiner Hanh Phan in the telephone interview that occurred on February 28, 2006, at 1:00 p.m. EST. In accordance with the requirements of 37 CFR 1.133(b), and the Manual of Patent Examining Procedure (MPEP) §713.04, Applicants provide the following written statement of the reasons presented at the interview as warranting favorable action.

Those participating in the interview were Examiner Hanh Phan, Supervisory Examiner Jason Chan, one of the inventors Heinz Willebrand, and the undersigned attorney of record.

No exhibits were shown or discussed. The claims that were discussed were claims 1, 2, 5, 6, 8, 15, 17-19 and 23-28 with respect to the cited prior art rejections, and claims 1-28 with respect to the Section 112, second paragraph, rejections. The prior art that was discussed was Vollert, Sato, Zavrel, Petsko, Mullaly et al., and Bloom. No proposed amendments were discussed.

The general thrust of the Applicants' principal argument that was discussed in the interview was Applicants' belief that there should be consistency between the rejections in the present application and in U.S. Application No. 09/800,917 to Izadpanah et al. (the '917 application). That is, many of the rejections are not believed to have been consistent, and claims 1-28 in the two applications are substantially the same. (Note: Applicants' claims 1 and 18 were slightly different than in the '917 application, but they are now believed to be the same due to the above amendment).

Specifically, with respect to the Section 112, Second Paragraph, and Section 103 rejections, Applicants explained their belief that these specific rejections have either not been entered or have been withdrawn without claim amendment in the '917 application. As such, Applicants believe that the examinations in the two applications have not been consistent.

With respect to the Bloom reference, Applicants explained that they previously amended claims 1 and 18 in response to Bloom. But claims 1 and 18 of the '917 application are not believed to have been rejected based on Bloom. As such, Applicants explained that they were considering undoing the previous amendment.

It is also noted that Applicants explained to the Examiners that Applicants' observations with respect to the '917 application were based on a review of publicly available

records. The observations are believed to be correct, but the accuracy of these observations should be confirmed before relying on them.

The interview ended with an agreement being reached that the Examiners would withdraw the Section 112, Second Paragraph, rejections. This agreement is confirmed in the Interview Summary mailed March 3, 2006. Examiner Chan also mentioned that it appeared to him that U.S. Patent No. 6,239,888 lacks support for the "SONET ring".

Objection to Claim 17

Applicants have amended claim 17 in the manner suggested by the Examiner to change "line of site" to --line of sight--. As such, the objection should be withdrawn.

Claim Rejections under 35 U.S.C. § 112

The Examiner rejected claims 1-28 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully traverse these rejections.

As mentioned in the above Statement of the Substance of the Interview, as well as the Interview Summary mailed March 3, 2006, the Examiner has agreed to withdraw these rejections. Therefore, these rejections are now moot.

Double Patenting Claim Rejections

(1) Claims 1, 5, 6, 18 and 23 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 6,763,195 to Willebrand et al. (the parent application hereto). Applicants respectfully traverse these rejections.

Applicants request that these rejections be held in

abeyance until the rejections under 35 U.S.C. 103 have been overcome so that the final form of the claims can be considered with respect to the double patenting claim rejections.

(2) Claims 1, 5, 6, 18 and 23 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of copending U.S. Application No. 10/840,172 to Willebrand et al. Applicants respectfully traverse these rejections.

Applicants request that these rejections be held in abeyance until the rejections under 35 U.S.C. 103 have been overcome so that the final form of the claims can be considered with respect to the double patenting claim rejections.

(3) Claims 1, 5, 6, 18 and 23 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 (renumbered) of U.S. Application No. 09/835,866 to Willebrand, now U.S. Patent No. 6,889,009 to Willebrand (the '009 patent). Applicants respectfully traverse these rejections.

Applicants assert that this double patenting rejection is clearly improper and must be withdrawn. The rejection is improper for at least two reasons.

First, the Examiner has simply not provided the detailed analysis that is required for an obviousness-type double patenting rejection. Specifically, Section 804 of the Manual of Patent Examining Procedure (MPEP) states:

"Any obviousness-type double patenting rejection should make clear: (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the

application; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim **>at issue would have been< an obvious variation of the invention defined in a claim in the patent. When considering whether the invention defined in a claim of an application *>would have been< an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art."

(MPEP § 804 Definition of Double Patenting) (emphasis added).

The Examiner has not identified the differences between the inventions defined by the claims in the present application as compared to the claims in the '009 patent. Furthermore, the Examiner has not provided the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claims of the present application would have been an obvious variation of the invention defined in the claims of the '009 patent. Instead, the Examiner simply states "see claims 1-7 and 15-24 of copending Application No. 09/835,866". Applicants assert that this is inadequate to support an obviousness-type double patenting rejection. Furthermore, there are no claims 15-24 in the '009 patent. Therefore, the rejections should be withdrawn.

A second reason that the rejections are improper is that the Examiner does not appear to be applying the correct test for determining an obviousness-type double patenting rejection. Specifically, the Examiner states that the limitations recited in claims 1, 5, 6, 18 and 23 of the instant application "are encompassed" by claims 1-7 of copending Application No. 09/835,866. In this regard, Section 804 of the MPEP states:

"Domination and double patenting should not be confused. They are two separate issues. One patent

or application 'dominates' a second patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds, cannot support a double patenting rejection." (MPEP § 804 Definition of Double Patenting) (emphasis added).

The test is not whether the claims of the present application are "encompassed" by the claims of the '009 patent. Instead, the Examiner must provide the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claims of the present application would have been an obvious variation of the invention defined in the claims of the '009 in the patent. Because the Examiner has not done this, the rejections must be withdrawn.

Therefore, Applicants assert that the double patenting rejections based on the '009 patent must either be withdrawn, or the Examiner must (1) identify the differences between each of the claims in the present application as compared to each of the claims in the '009 patent; and (2) provide the reasons why a person of ordinary skill in the art would conclude that the each of the claims of the present application would have been an obvious variation of each of the claims of the '009 patent.

Claim Rejections under 35 U.S.C. § 103

(1) The Examiner rejected claims 1, 2, 5, 6, 8, 18, 19, 23 and 25-28 under 35 U.S.C. § 103(a) as being unpatentable over all of the following combinations of references:

- Vollert, Publication No. DE 4433896 C1, in view of Mullaly et al., U.S. Patent No. 6,812,881.

- Sato, U.S. Patent No. 4,904,993, in view of Mullaly et al.
- Zavrel, U.S. Patent No. 5,585,953, in view of Mullaly et al.
- Petsko, U.S. Patent No. 5,999,294, in view of Mullaly et al.

Applicants respectfully traverse all of these rejections.

With respect to Applicants' independent claims 1 and 18, the Examiner asserts that it would have been obvious to one having ordinary skill in the art to incorporate a laser portion into the systems of Vollert, Sato, Zavrel, and Petsko based on Mullaly et al. (See Office Action mailed 11/17/05, pages 8, 11-12, 15, and 18). The Examiner states that the motivation for making such a modification is that Mullaly et al. allegedly suggests that using a laser portion has the advantage of "allowing transmitting data with high speed, high capacity and for longer distance." (See Office Action mailed 11/17/05, pages 8, 12, 15, and 18).

Applicants argued in their last response that a proper *prima facie* case of obviousness of Applicants' claims had not been established. Applicants reasoned that the Examiner had not shown where Vollert, Sato, Zavrel, and Petsko (i.e. the primary references) themselves teach the need for a light source for transmitting data with narrow spectral width, coherent, and highly directional. (See Applicants' Response to Final Office Action mailed February 25, 2005). In other words, Applicants were essentially arguing that the Examiner has not shown proper motivation to combine the references.

The Examiner's response to Applicants' argument appears to be two-fold. First, the Examiner states that "Applicant argues that the cited references (Vollert, Mullaly, Sato, Zavrel and Petsko) fail to [teach] the limitation of 'the

light source for transmitting data is laser source' of independent claims 1 and 18." (See the Examiner's "Response to Arguments" on page 21 of the Office Action mailed 11/17/05). ***This statement by the Examiner, however, is simply not correct.*** Namely, that is not what Applicants argued. Instead, Applicants argued that the Examiner had not shown where each of the primary references themselves (i.e. Vollert, Sato, Zavrel and Petsko, but not Mullaly et al.) teaches the need for a light source for transmitting data with narrow spectral width, coherent, and highly directional. Again, Applicants were essentially arguing that the Examiner has not shown proper motivation to combine the references. As such, the Examiner has not responded to Applicants' argument.

The second way the Examiner appears to have attempted to respond to Applicants' argument is that the Examiner changed the language of the rejections from "advantage of allowing providing a light source for transmitting data with narrow spectral width, coherent, and highly directional" to --advantage of allowing transmitting data with high speed, high capacity and for longer distance--. (See Office Action mailed 11/17/05, pages 8, 12, 15, and 18). However, this is not responsive to Applicants' argument either since the Examiner is alleging that Mullaly et al. (i.e. the secondary reference) suggests this advantage. In other words, this changed language in the rejections does not respond to Applicants' argument that the Examiner has not shown where each of the primary references themselves (i.e. Vollert, Sato, Zavrel and Petsko, but not Mullaly et al.) teaches the need for a light source for transmitting data with narrow spectral width, coherent, and highly directional.

What is more, the Examiner now alleges that Mullaly et al. suggests in column 9, lines 17-33 the advantage of

allowing transmitting data with high speed, high capacity and for longer distance. However, Applicants simply cannot find this advantage stated in the portion of Mullaly et al. cited by the Examiner.

Therefore, Applicants assert that the Examiner has not responded to Applicants argument that a proper *prima facie* case of obviousness of Applicants' claims has not been established.

Specifically, Applicants assert that the Examiner has not shown the proper motivation to combine the references. Even if the primary references of Vollert, Sato, Zavrel and Petsko can each be combined with Mullaly et al. and modified as suggested by the Examiner (and Applicants are not in any way admitting, suggesting or agreeing that they can be), Applicants assert that the Examiner has still failed to establish a proper *prima facie* case of obviousness of Applicants' claims 1 and 18 because he has not shown how the references suggest the desirability of the combination with Mullaly et al.

Namely, Section 2143.01 of the Manual of Patent Examining Procedure (MPEP) states:

"III. < FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)"

(MPEP § 2143.01 Suggestion or Motivation To Modify the References [R-3]) (first emphasis in original, second emphasis added).

This MPEP rule clearly states that the prior art must suggest the desirability of the combination. Applicants assert that

the Examiner has not shown where the prior art suggests the desirability of the combination. Specifically, as Applicants argued in their last response the Examiner has not shown where each of the primary references themselves (i.e. Vollert, Sato, Zavrel and Petsko, but not Mullaly et al.) teaches the need for a light source for transmitting data with narrow spectral width, coherent, and highly directional. And the Examiner's changes to the rejections described above also does not show where each of the primary references themselves (i.e. Vollert, Sato, Zavrel and Petsko, but not Mullaly et al.) teaches the need for a laser portion having the advantage of allowing transmitting data with high speed, high capacity and for longer distance. And as also described above, Applicants simply cannot find this advantage stated in the portion of Mullaly et al. cited by the Examiner. Therefore, again, Applicants assert that the Examiner has not shown where the prior art suggests the desirability of the combination. As such, the rejections of Applicants' independent claims 1 and 18 must be withdrawn. Furthermore, the rejections of dependent claims 2, 5, 6, 8, 19, 23 and 25-28 must also be withdrawn for at least the same reasons.

(2) The Examiner rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over all of the following combinations of references:

- Vollert, Publication No. DE 4433896 C1, in view of Mullaly et al., U.S. Patent No. 6,812,881, and further in view of Avakian, U.S. Patent No. 4,727,600.
- Sato, U.S. Patent No. 4,904,993, in view of Mullaly et al., and further in view of Avakian.
- Zavrel, U.S. Patent No. 5,585,953, in view of

Mullaly et al., and further in view of Avakian.

- Petsko, U.S. Patent No. 5,999,294, in view of Mullaly et al., and further in view of Avakian.

Applicants respectfully traverse all of these rejections.

Applicants assert that the rejection of dependent claim 17 should be withdrawn for at least the same reasons provided above for its independent claim 1.

(3) The Examiner rejected claims 15 and 24 under 35 U.S.C. § 103(a) as being unpatentable over all of the following combinations of references:

- Vollert, Publication No. DE 4433896 C1, in view of Mullaly et al., U.S. Patent No. 6,812,881, and further in view of Perdue et al., U.S. Patent No. 6,529,556.
- Sato, U.S. Patent No. 4,904,993, in view of Mullaly et al., and further in view of Perdue et al.
- Zavrel, U.S. Patent No. 5,585,953, in view of Mullaly et al., and further in view of Perdue et al.
- Petsko, U.S. Patent No. 5,999,294, in view of Mullaly et al., and further in view of Perdue et al.

Applicants respectfully traverse all of these rejections.

Applicants assert that the rejection of dependent claims 15 and 24 should be withdrawn for at least the same reasons provided above for their respective independent claims 1 and 18.

Amendments to Independent Claims 1 and 18

In the above amendment Applicants have amended claims 1 and 18 to undo the amendment that was made in Applicants' amendment filed on November 24, 2004. It appears to Applicants at this time that the amendment is not necessary.

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Fees Believed to be Due

No extra claims fee are believe to be due.

A Fee is submitted herewith to cover the Petition for a two-month extension of time.

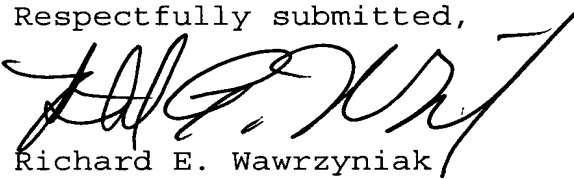
C O N C L U S I O N

Should there be any outstanding issues that require adverse action with respect to this amendment, it is respectfully requested that the Examiner telephone Richard E. Wawrzyniak at (858)552-1311 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

Dated

4/17/06


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